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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051860
Party	Plaintiff La Montre Hermes S.A.
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Attachments	Motion to Amend Petition for Cancellation.pdf ( 8 pages )(3785666 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

LA MONTRE HERMES S.A.,

*Petitioner,*

v.

MICHAEL AKKAWI,

*Registrant.*

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BOX TTAB

CANCELLATION NO.  
92-051860  
(Reg. No. 3,433,601)

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**MOTION TO AMEND PETITION FOR CANCELLATION**

Pursuant to Rule 15(a), Fed. R. Civ. P., and Rules 2.107 and 2.115 of the Rules of Practice, Petitioner hereby moves to amend its Petition for Cancellation in this action to add two additional grounds for cancellation.

The initial Petition for Cancellation alleged only the prior rights of Petitioner in the trademark CAPE COD for watches, and sought cancellation of Registrant's registration of CAPE COD WATCH ("Registrant's Mark") only on grounds of likelihood of confusion under Section 2(d) of the Lanham Act. In its incomplete and tardy responses to Petitioner's discovery, the last of which was served on June 17, 2010, Registrant has made clear that (1) Registrant's Mark was used entirely in intrastate commerce prior to the filing of Registrant's application and has never been "used in commerce" either before or after filing the application, and (2) Registrant has never sold "clocks" or "jewelry" under Registrant's Mark. Therefore, Petitioner is now has a reasonable basis to allege two additional grounds for cancellation: that the application was void

*ab initio* for failure to have used the mark in commerce prior to filing, and that the registration may be cancelled – at least with respect to jewelry and clocks – on grounds of nonuse or fraud.

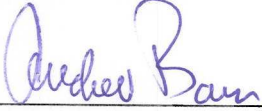
The TTAB Manual of Procedure (“TBMP”) provides that “if a party learns, through discovery or otherwise, of information which would serve as the basis for an additional claim...the party should move promptly to amend its pleading to assert the additional matter.” That is exactly what Petitioner is doing here. Petitioner has learned of new grounds for cancellation during the discovery period and has moved promptly to amend the pleadings during the discovery period. Amendment of the pleadings is necessary in order to permit Petitioner to seek cancellation on these substantial and material grounds, since this Board strictly prohibits consideration, at final hearing, of any unpleaded claims or issues. TBMP § 314; *see, e.g., Levi Strauss & Co. v. R. Josephs Sportwear, Inc.*, 28 USPQ2d 1464, 1471 n.11 (TTAB 1993); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1439-40 (TTAB 1993). Granting this motion during the discovery period will cause no prejudice to Registrant, since there will be ample time consider and take discovery on these new issues.

This Board “liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires...even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint.” TBMP § 507.02. Such relief is appropriate here. In accordance with TBMP § 507.01, a signed copy of the proposed Amended Petition is attached.

WHEREFORE, Petitioner respectfully requests that its motion to file the attached First Amended Petition for Cancellation be granted.

Respectfully submitted,

FOLEY & LARDNER LLP

By:   
Andrew Baum  
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*Attorneys for Petitioner*  
La Montre Hermes S.A.

Dated: New York, New York  
July 14, 2010

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing MOTION TO AMEND PETITION FOR CANCELLATION was served by first-class mail to the Registrant at the address of record as follows:

Michael Akkawi  
8 Plum Hollow Road  
East Falmouth, MA 02536

and by email to:

Milton Oliver, Esq.  
Oliver Intellectual Property LLC  
Box 1670  
Cotuit, MA 02635-1670

Date: July 14, 2010

  
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Mary A. Melvin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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LA MONTRE HERMES S.A.,

*Petitioner,*

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MICHAEL AKKAWI,

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BOX TTAB

CANCELLATION NO.

92-051860

(Reg. No. 3,433,601)

**FIRST AMENDED PETITION FOR CANCELLATION**

La Montre Hermes S.A. ("Petitioner"), a corporation of Switzerland located at Erlenstrasse 31A, 2555 Brugg, Switzerland, believes that it is being damaged by the registration of the mark CAPE COD WATCH ("Registrant's Mark"), U.S. Trademark Registration No. 3,433,601 covering "clocks and watches; jewelry and watches; jewelry clocks and watches; jewelry watches, watch bracelets" in International Class 14 ("Registrant's Goods"), owned by Michael Akkawi ("Registrant"), an individual residing, upon information and belief, at 8 Plum Hollow Road, East Falmouth, Massachusetts 02536, and hereby requests cancellation of same.

The grounds for this petition are:

1. Continuously since long prior to Registrant's first use, Petitioner has manufactured high quality watches and sold them throughout the world and the United States.
2. Continuously since long prior to Registrant's filing date and claimed date of first use, Petitioner has manufactured and sold watches throughout the United States under the name and trademark CAPE COD.



3. Petitioner's CAPE COD line of watches has been sold for many years in the United States, generating millions of dollars in revenue to Petitioner. As a result of the high quality of Petitioner's CAPE COD watches, the extensive advertising of the brand, and the wide and favorable publicity which Petitioner's CAPE COD watches has received, the trademark CAPE COD has become associated with Petitioner exclusively as a trademark for watches.

4. One of the models in Petitioner's CAPE COD line of watches is CAPE COD 2 ZONES. Petitioner has sold watches in the United States under the name and trademark CAPE COD 2 ZONES continuously since long prior to Registrant's filing date and claimed date of first use.

5. Petitioner is the owner of U.S. Trademark Registration 2,753,802 for its trademark CAPE COD 2 ZONES for watches, which registration is in full force and effect and is incontestable.

6. Registrant is the owner of U.S. Trademark Registration No. 3,433,601 for the mark CAPE COD WATCH covering Registrant's Goods.

7. Registrant manufactures Registrant's Goods in Massachusetts and has sold them only to two retail stores in Massachusetts. Registrant maintains a website on which watches bearing Registrant's Mark appear, but the watches have never been available for purchase through the website. Upon information and belief, except for the website, Registrant has never advertised or promoted any goods under Registrant's Mark outside of Massachusetts.

8. Registrant has never sold any "clocks," "jewelry," or "jewelry clocks" under Registrant's Mark. Upon information and belief, at the time he filed the application for the Registration, Applicant knew he had never used Registrant's Mark on clocks or jewelry and

alleged use on such goods in order to induce the Trademark Office to grant a registration of broader scope than that to which he was entitled.

### **COUNT I – LIKELIHOOD OF CONFUSION**

9. Registrant's mark CAPE COD WATCH is so similar to Petitioner's trademarks CAPE COD and CAPE COD 2 ZONES that, when applied to identical goods and closely related goods, there is a likelihood of confusion, mistake or deception, which will cause damage to Petitioner.

10. Registration of Registrant's mark CAPE COD WATCH is barred by Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), because it consists of or comprises a mark which so resembles trademarks previously used and registered by Petitioner as to be likely, when applied to the goods of Registrant, to cause confusion, to cause mistake, or to deceive.

### **COUNT II – LACK OF USE IN COMMERCE**

11. Registrant's registration should be cancelled because Registrant's Mark was not in use in commerce at the time the application therefor was filed, and therefore the application was void *ab initio* under Section 1 of the Lanham Act. Further, Registrant's Mark has never been used in interstate or foreign commerce, either before or after the application was filed.

### **COUNT III - FRAUD**

12. Because Registrant knowingly alleged use of Registrant's Mark on "jewelry," "jewelry clocks" and "clocks" in his application, when there had never been any use of the mark on such goods, Registrant's Registration should be cancelled on grounds of fraud.




Alternatively, "jewelry," "jewelry clocks" and "clocks" should be deleted from the specification of goods in the registration.

**WHEREFORE**, Petitioner prays that Registration No. 3,433,601 be cancelled.

Respectfully submitted,

FOLEY & LARDNER LLP

Dated: New York, New York  
July 14, 2010

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